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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/474,783	12/30/1999	DONALD K. NEWELL	2207/6929	2707
7590	05/09/2005		EXAMINER	
John F Kacvinsky c/o Blakely Sokoloff Taylor & Zafman LLP 12400 Wilshire Boulevard Seventh floor Los Angeles, CA 90025			NALEVANKO, CHRISTOPHER R	
			ART UNIT	PAPER NUMBER
			2611	

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/474,783	NEWELL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Christopher R. Nalevanko	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 February 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,4-7,9 and 12-21 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,4-7,9 and 12-21 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                             |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                        | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/15/2004 has been entered.

### ***Response to Arguments***

1. Applicant's arguments filed 11/15/2004 have been fully considered but they are not persuasive.

Regarding Claim 1, Applicant argues that "As correctly noted in the Office Action, Russo fails to disclose control information embedded in the broadcast content. Office Action, Page 3. Russo also fails to describe a 'descriptor,' which is a data structure used to convey the control information and/or descriptive information" (page 8 lines 3-5). Examiner asserts that it was not admitted that Russo fails to show control information. Although Russo does show sending the control data with the broadcast information (col. 8 lines 65-67, col. 9 line 1, supplemental information may be from program provider along path 102, using modulation/demodulation capabilities), it was merely admitted that Russo fails to specifically state that the control information was *embedded* in the broadcast content. The Horton reference is used to show *embedding* control information into a broadcast stream (col. 3 lines 38-67, coded information embedded in the TV signal). Russo clearly shows sending control information to the user (col. 6 lines 12-52, key sent with broadcast to allow decoding, col. 7 lines 55-67, keys allowing

decoding to only those selected subscribers). Furthermore, this control information is clearly descriptive of the control information and the control functions which are to be implemented by the data. The term “descriptor” is no more limiting or clarifying than the previously disclosed limitation of “control information.”

Applicant further argues that Russo “fails to describe a ‘descriptor’ in any context, let alone a descriptor to indicate “a length of time the playback device may reproduce the received broadcast content’ as recited in claim 1” (page 8 lines 13-15). First, as discussed above, Russo clearly shows control information, or a descriptor (col. 6 lines 12-52, key sent with broadcast to allow decoding, col. 7 lines 55-67, keys allowing decoding to only those selected subscribers). The term “descriptor” is no more limiting or clarifying than the previously disclosed limitation of “control information.” Additionally, Russo also shows that this descriptor data indicates a length of time the playback device may reproduce the broadcast content (col. 5 lines 32-46, viewer may be allowed to view the selected program as many times as desired over a particular time). This clearly meets the limitations of indicating a length of time the playback device may reproduce the content.

Applicant further argues that “Russo fails to describe ‘the descriptor to indicate whether the storage device may store the received broadcast content’ as recited in claim 1. The Office Action was silent regarding whether Russo discloses this language, and instead refers the Applicant to Horton” (page 8 lines 16-19). Examiner clearly stated in the previous Office Action that “Russo also fails to show that the control information defines the action to store the received broadcast content or reproduce the received broadcast content. Horton shows broadcasting audio visual content along with embedded control information to define an action to be taken

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pertaining to the received content, specifically storing the received broadcast content (col. 3 lines 38-67, ‘coded information embedded in the TV signal,’ ‘indication...of various modes available with this particular program’).” It is unclear what the Applicant is arguing. It was never asserted that Russo disclosed the claimed language and it was clearly asserted that Horton does show the claimed limitations. Horton shows the sending control information that indicates if a particular broadcast content can be stored (col. 3 lines 28-67, coded information indicating various modes of operation, such as view only or view and tape).

Applicant further argues that “Horton fails to disclose the missing language of claim 1. For example, Horton fails to disclose ‘a length of time the playback device may reproduce the received broadcast content’ as recited in claim 1” (page 8 lines 20-22). As discussed above, Russo clearly shows this claimed limitation and Horton is not relied upon to disclose the limitation.

Regarding Claims 1, 4, 5-7, 9, 12-21, in response to Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Applicant further argues that “Russo fails to show a ‘descriptor’ in any context, let alone ‘a descriptor embedded in the received broadcast content...’ Therefore, Russo clearly fails to provide the proper motivation to make the combination alleged by the Office. Similarly, Horton fails to discuss ‘a length of time the play back device may

reproduce the received content' in any context...Furthermore, the Office does not set forth a clear line of reasoning or suggestion as to why it would have been desirable for a person of ordinary skill in the art to make the alleged combination of Russo and *Hancock* to arrive at the subject matter of the claimed subject matter" (page 9 lines 22-23 to page 10 lines 1-11). First, the Examiner does not rely on a *Hancock* reference and there is no reference to this piece of art in the previous rejection. Additionally, as discussed above, Russo clearly shows using a descriptor, or control information, to indicate the length of time the play back device may reproduce the received content (col. 5 lines 32-46, viewer may be allowed to view the selected program as many times as desired over a particular time). Russo merely fails to specifically state that this descriptor information is *embedded* in the broadcast content and can control the ability to record. Horton clearly shows broadcasting audio visual content along with embedded control information to define an action to be taken pertaining to the received content, specifically storing the received broadcast content (col. 3 lines 38-67, 'coded information embedded in the TV signal,' 'indication...of various modes available with this particular program'). The specification of Russo and Horton make it clear that this descriptor or control information can prevent unauthorized use or recording of broadcast media. Furthermore, this allows broadcasters to set various fees for media consumption. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo with the ability to specify the action as storing the content and embedding control information as in Horton in order for the broadcast provider to specify what could be done to the broadcast programs. This could help prevent unauthorized copying and also allow the user to only access certain programs.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4-7, 9, and 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo in further view of Horton et al.

Regarding Claim 1, Russo shows a system for controlling use of broadcast content comprising a receiver in communications with a source of broadcast content and a playback device and a storage device, wherein the receiver is configured to control the use of the received broadcast content through the playback device and storage device in accordance with descriptor in the received broadcast content (col. 3 lines 3-28 and 50-60, col. 6 lines 12-25, col. 8 lines 55-67, see figure 2). Russo shows that a storage device is couple to the receiver (col. 3 lines 3-20, see figure 1 item 14 ‘program storage’).

Furthermore, the authorization key and compression algorithms directly define actions or operations to be taken pertaining the broadcast data. Russo shows that descriptor information indicates a length of time that the received broadcast content may be consumed (col. 5 lines 32-46, viewer may be allowed to view the selected program as many times as desired over a particular time). Although Russo shows that the descriptor information is in the broadcast content stream (col. 8 lines 65-67, col. 9 line 1), he fails to specifically state that this control information is embedded in the content. Russo also fails to show that the descriptor information defines the action to store the received

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broadcast content or reproduce the received broadcast content. Horton shows broadcasting audio visual content along with embedded descriptor information to define an action to be taken pertaining to the received content, specifically storing the received broadcast content (col. 3 lines 38-67, ‘coded information embedded in the TV signal,’ ‘indication...of various modes available with this particular program’). Horton shows that the receiver can store broadcast content in the storage devise based on the descriptor information (col. 3 lines 38-67, ‘coded information embedded in the TV signal,’ ‘indication...of various modes available with this particular program,’ ‘view and tape for fee, view and tape for free’). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo with the ability to specify the action as storing the content and embedding descriptor information as in Horton in order for the broadcast provider to specify what could be done to the broadcast programs. This could help prevent unauthorized copying and also allow the user to only access certain programs.

Regarding Claim 4, Russo further shows that the receiver is configured to maintain information relating to the use of the received broadcast content (col. 3 lines 20-25, col. 5 lines 48-65).

Regarding Claim 5, Russo shows that the receiver is configured to use the information relating to the use of the received broadcast content for remuneration of a provider of content (col. 4 lines 45-67, col. 5 lines 20-33, col. 6 lines 34-55).

Regarding Claim 6, Russo shows that the information relating to the use of the received broadcast content comprises a duration of use (col. 5 lines 32-47).

Regarding Claim 7, Russo shows a method comprising receiving broadcast content, extracting a descriptor from the received broadcast content (col. 6 lines 12-32, col. 8 lines 55-67) and controlling the use of the received content in accordance with the descriptor, the descriptor indicating a length of time the received broadcast content may be reproduced (col. 6 lines 12-32, col. 9 lines 48-67, col. 5 lines 34-60, col. 4 lines 45-67, viewer may be allowed to view the selected program as many times as desired over a particular time). Furthermore, the authorization key and compression algorithms directly define actions or operations to be taken pertaining the broadcast data. Although Russo shows that the descriptor is in the broadcast content stream (col. 8 lines 65-67, col. 9 line 1), he fails to specifically state that this descriptor information is embedded in the content. Russo also fails to show that the descriptor information defines the action to store the received broadcast content or reproduce the received broadcast content. Horton shows broadcasting audio visual content along with embedded descriptor information to define an action to be taken pertaining to the received content, specifically storing the received broadcast content (col. 3 lines 38-67, ‘coded information embedded in the TV signal,’ ‘indication...of various modes available with this particular program’). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo with the ability to specify the action as storing the content and embedding descriptor information as in Horton in order for the broadcast provider to specify what could be done to the broadcast programs. This could help prevent unauthorized copying and also allow the user to only access certain programs.

Regarding Claim 9, Russo does show lengths of time and days that the broadcast may be viewed (col.5 lines 33-48). Russo fails to show that the descriptor information indicates the number of times the received broadcast content may be consumed. Limiting the number of times is a logical variation of the restriction of viewing already set forth by Russo and therefore would have been obvious to one of ordinary skill in the art at the time the invention was made. This would enable the broadcast facility to supply the viewer with various pricing and viewing options.

Regarding Claim 12, Russo shows that the video can be saved for a predetermined length of time but doesn't specifically state a date range (col. 5, lines 32-46). It is nonetheless inherent that this time period would be more than one day, thus covering a range of dates.

Regarding Claim 13, it is inherent that the information sent to the user site would include billing information (col. 6 lines 10-27).

Regarding Claim 14, it is inherent that the information sent to the user site would contain information for the cost of consuming the broadcast (col. 6 lines 10-27).

Regarding Claim 15, Russo shows the ability to "unlock" certain viewing options with a code sent along with the video stream (col. 6 lines 10-27). This inherently prevents the unjustified use of the broadcast material since other options would remain locked.

Regarding Claim 16, Russo shows obtaining payment information from the user (col. 6 lines 20-28, lines 35-46, col. 10 lines 10-48).

Regarding Claim 17, Russo shows communicating consumption information to a billing facility (col. 6 lines 34-53, col. 10 lines 10-48).

Regarding Claim 18, Russo shows that the billing facility comprises a facility maintained by a provider of the broadcast content (col. 6 lines 20-36).

Regarding Claim 19, Russo shows a storage medium containing a set of instructions for execution by a computer (see figure 2 items 136, 156, 150, 158). This clearly shows that the invention of Russo is capable of being carried out by a computer controlled medium. All further limitations of the Claim have been addressed in Claim 7.

Regarding Claim 20, it is further understood that the memory shown in Russo is accessible by a computer.

Regarding Claim 21, Russo fails to show that the storage medium comprises a portable storage device. Official Notice is taken that it is well known and expected in the art to use removable storage devices, such as CD-ROMs or removable hard drives. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Russo with a portable storage device so that the instructions could be transported to other systems.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Nalevanko whose telephone number is 571-272-7299. The examiner can normally be reached on M-F 8-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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